

REMARKS

At the outset, Applicant wishes to thank Examiner Tawfik for the courtesies extended to Applicant's representatives during their telephonic on August 22, 2007. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

In the Office Action, claims 1-11, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §103(b) as allegedly being unpatentable over U.S. Patent No. 5,554,094 to *Viens*.

Summary of the Response to the Office Action

Applicant respectfully submits that the previously amended features of independent claims 1, 16, and 33 are not taught or suggested by the applied references of record. Claims 34 and 35 are cancelled without prejudice or disclaimer. Claims 36 and 37 are added to provide an alternative scope of protection. Claims 12-15, 17, and 22-30 are withdrawn from consideration. Accordingly, claims 1-11, 16, 18-21, 31-33, and 36-37 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-11, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §103(b) as allegedly being unpatentable over *Viens*. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to

combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

Viens does not disclose at least “a folding mode selecting device . . . [that] . . . selectively causes the sheet folding unit to operate one of the folding modes,” as recited in independent claims 1, 16, and 33. That is, there is no folding mode selecting device in *Viens* because *Viens* teaches that an operator or user manually changes each folding apparatus 12 to perform either Z-folding, C-folding, or half-folding of sheets. See at least col. 4, line 61 through col. 5, line 8 of *Viens*. The user cannot be the equivalent of a folding mode selecting device.

The Office Action’s admits that *Viens* does not show the claimed “folding mode selection selecting device,” and that *Viens* operates to select the mode manually “via the user.” In light of these admissions, the Office Action asserts that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified *Viens*’ sheet folding machine by using a folding mode selecting device to replace the manual work of changing the folding mode, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.” See page 2, last paragraph, to page 3, first paragraph, of the Office Action.

The Office Action cites *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) for the proposition that “broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” The Office Action stretches *In re Venner* beyond its scope because the automatic or

mechanical movement of the present invention is not just a matter of automating the manual replacement of the separate folding apparatuses (12) of *Viens*, with their unique sheet paths, to enable the letter Z-folding, letter C-folding, and Half-folding of the sheets. The unique structures of the folding apparatuses (12) of *Viens*, with their respective types of folding, are different from each other in the number of bypass devices used, positions of the bypass devices, number of the buckle plates used, and position of the buckle plates used for each folding mode. These unique structures cannot be simply automated when they do not even share common structure. The Office Action's unsupported assumption that the present invention is an obvious automation of *Viens* is analogous to saying that a motorcycle is an obvious automation of a bicycle.

The Office Action maintains that the computer in *Viens* performs functions related to automatically selecting a folding mode. See page 2 of the Office Action. Column 4, lines 24-27 of *Viens* actually states that “[a] computer processing unit (not shown) including two keyboard/monitor units 14A, 14B allows the user to track the operation of the system 10.” The citation from *Viens* does not support the Office Action’s assertion that a user could automatically select which folding mode to use. The tracking of a folding job by a computer as described in col. 4, lines 24-27 of *Viens* is not the same as “a folding mode selecting device” as recited in claims 1, 16, and 33. Thus, the statement in the Office Action is erroneous.

In reality, *Viens* actually discloses three separate sheet folding apparatus 12 that have different folding sheet paths. Each sheet folding apparatus 12 can be exchanged to perform Z-folding, C-folding, and half-folding of sheets. The different sheet paths are shown in Figs.

5A-5B, 6A-6B, and 7A-7B, respectively. The sheet folding apparatus 12, and hence their sheet paths, are manually exchanged from one to another. See col. 1, lines 65-67; col. 4, line 61 through col. 5, line 8; col. 6, lines 29-35; and col. 8, lines 48-52 of *Viens*. As admitted in the Office Action, *Viens* does not explicitly teach any “folding mode selecting device” that causes an exchange or reconfiguration of the folding apparatuses. Thus, it can be argued that *Viens* teaches away from the present invention because *Viens* discloses sheet folding apparatus 12 with different sheet paths that must be manually exchanged to enable the Z-folding, C-folding, and half-folding of sheets. See col. 4, line 61 through col. 5, line 8; col. 5, line 9 through col. 8, line 30; and Figs. 5A-5B, 6A-6B, and 7A-7B of *Viens*.

Further, *Viens* does not disclose at least “the folding mode selecting device causes the folding position changing mechanism to change a sheet folding position in accordance with a selected one of the folding modes,” as recited in independent claims 1, 16, and 33. *Viens* performs the Z-fold on a product 28 by using a bypass device 91. The bypass device 91 is located in a fourth path after a nip 88 and deflects the product 28 into a nip formed between a roller 90 and a roller 96 (see Fig. 5A; col. 5, line 39 through col. 6, line 29). To the contrary, to perform a C-fold on the product 28, a bypass device 102 is mounted at a second station 66, and a buckle plate 104 is mounted in a third station 68 (see Figs. 6A and 6B; col. 6, line 30-34). It is clear from the figures in *Viens* that the bypass device 91 and the buckle plate 104 are mounted at positions where the bypass device 91 and the buckle plate 104 interfere with each other. Thus, when a mode is changed from the Z-fold to that C-fold, it appears necessary in *Viens* to move the bypass device 91 and then mount the buckle plate 104. In other words, the buckle plate 104

seems to be mounted manually, and an adjustable stop 106 also seems to be mounted manually. To the contrary, independent claims 1, 16, and 33 recite that “the folding mode selecting device causes the folding position changing mechanism to change a sheet folding position in accordance with a selected one of the folding modes.” Accordingly, Applicant respectfully submits that independent claims 1, 16, and 33 cannot be obvious over *Viens*.

In the present invention, the letter Z-folding, letter C-folding, and Z-folding of sheets require only a single configured sheet path. See at least page 12, lines 21-24 of the specification. All three types of sheet folding can be accomplished with one single sheet path configuration as seen in Fig. 3 of the specification. No alternate sheet paths are necessary and no manual exchange of parts is needed to accommodate the different folding modes of the present invention.

Additionally, Applicant respectfully asserts that “a mode switch that allows a user to select one of a plurality of folding modes,” as recited in independent claims 1, 16, and 33, is not even discussed in the Office Action. If the Office Action alleges such a feature is obvious, the Office Action at a minimum should identify each and every feature taught or suggested in *Viens*. As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Viens* fails to teach or suggest each feature of independent claims 1, 16, and 33, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 2-11, 18-21, and 31-32 depend from one of independent claims 1, 16, and 33. Accordingly, claims 2-11, 18-21, and 31-32 are also allowable because of the additional features they recite and the reasons stated above.

New Claims

Applicant respectfully requests allowance of dependent claims 36-37, which depend from independent claims 1 and 16, respectively. The claims are allowable insofar as they recite the patentable combinations of features recited in their base claim, as well as reciting additional features that further distinguished over the applied prior art. Accordingly, in view of the above amendments, claims 36-37 are allowable and pending for further consideration.

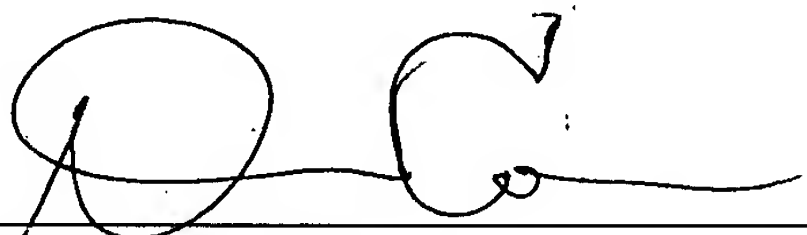
CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 
David E. Connor
Reg. No. 59,868

Dated: September 28, 2007

Customer No. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
Tel: 202-739-3000